

REMARKS

A. 35 U.S.C. §102

In the Office Action mailed on November 23, 2005, claims 1 and 9-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ernst. Applicant traverses the rejection. Independent claim 1 recites a position measuring system that includes a wall having a deformation and a cable having a shield. The Office Action has identified item 67 as an opening of the housing 64 and defines a deformation. However, item 67 is a component separate from the wall as shown by its different cross hatching pattern. Since item 67 does not form part of the wall of the housing, it is not a deformation of that very same wall. Accordingly, claim 1 is not anticipated by Ernst and the rejection is improper. Despite the impropriety of the rejection, claim 1 has been amended to clarify that the deformation is integral with the wall. Since item 67 of Ernst is not integral with the wall, the rejection should be withdrawn.

The rejection is improper for the additional reason that Ernst does not disclose that the cable cord 66 has a shield. The Office Action asserts that FIG. 6 suggests such a shield. A review of FIG. 6 does not show that a shield is suggested. At most, FIG. 6 shows cable cord 66 is an ordinary cable with a covering of supposedly electrically insulating material. Since FIG. 6 fails to show a shield and the rest of Ernst does not disclose or suggest a shield for cable cord 66, claim 1 is not anticipated by Ernst. Accordingly the rejection should be withdrawn. Despite the impropriety of the rejection, claim 1 has been amended to clarify that the deformation binds the shield to the housing “so as to provide a secure electrical contact between said shield and said

housing.” There is no disclosure in Ernst that cable cord 66 provides an electrical contact with a housing. Accordingly, the rejection should be withdrawn.

Besides not being anticipated by Ernst, claim 1 is not rendered obvious by Ernst since there is no motivation in Ernst or the prior art to alter Ernst to have its wall include an integral deformation and to use a cable having a shield which forms an electrical contact with a housing. Without such suggestion, claim 1 and its dependent claims should be deemed patentable over Ernst.

B. 35 U.S.C. §103

1. Ernst

Claims 6 and 7 were rejected under 35 U.S.C. § 103 as being obvious in view of Ernst. Claims 6 and 7 depend directly on claim 1. As mentioned above in Section A, there is no motivation in Ernst or the prior art to alter Ernst to have its wall include an integral deformation and to use a cable having a shield which forms an electrical contact with a housing. Without such suggestion, the rejection is improper and should be withdrawn.

The rejection of claim 6 is improper for the additional reason that there is no suggestion in Ernst to use an adhesive provided in the opening between the cable cord 66 and the housing. Without such suggestion, the rejection is improper and should be withdrawn.

The rejection of claim 7 is improper for the additional reason that there is no suggestion in Ernst to use an intermediate ply provided in the opening between the cable cord 66 and the housing. Without such suggestion, the rejection is improper and should be withdrawn.

It is noted that the Office Action has failed to provide any motivation based on Ernst or the prior art to use the adhesive or intermediate ply recited in claims 6 and 7. Instead, the Office

Action imposes an obvious to experiment standard. Such a standard is improper. *In re Dow Chem. Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). The Office Action imposes yet another improper standard in that it relies on Applicant's own intended use for his own invention to provide motivation to reject the claims. This is a clear instance of improper hindsight being used to reject the invention. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Instead, the test is whether the reference in question, in this case Ernst, taken as a whole would suggest the invention to one of ordinary skill in the art. *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 220 USPQ 97 (Fed. Cir. 1983).

It is noted that the Office Action has cited the *In re Leshin* case for the proposition that the material of claims 6 and 7 would have been obvious based on Applicant's intended use for the material. It appears that the Office Action is relying on the following sentence of *In re Leshin*:

Mere selection of known plastics to make a container-dispenser of a type made of plastics prior to the invention, the selection of the plastics being on the basis of suitability for the intended use, would be entirely obvious; and in view of 35 U.S.C. 103 it is a wonder that the point is even mentioned. *In re Leshin*, 277 F.2d 197, 199, 125 USPQ 416, 418.

While there is mention of "intended use" for the selection of a material, the "intended use" is directed to the prior art being applied since the same sentence looks to plastics "prior to the invention." Since the Applicant of *In re Leshin* could not have an intended use that occurred before its invention, the phrase "intended use" must have been directed to the art cited in the case. Since no intended use in Ernst would suggest the materials in claims 6 and 7, the rejection

is improper and should be withdrawn.

2. Ernst and Schneider et al.

Claims 2-5 and 8 were rejected under 35 U.S.C. § 103 as being obvious in view of Ernst and Schneider et al. Claim 2 depends directly on claim 1. As mentioned above in Section A, Ernst fails to suggest having its wall include an integral deformation and to use a cable having a shield which forms an electrical contact with a housing. Schneider et al. fails to cure the deficiencies of Ernst in that it fails to suggest altering Ernst's wall to include an integral deformation and to use a cable having a shield which forms an electrical contact with a housing. Without such suggestion, the rejection is improper and should be withdrawn.

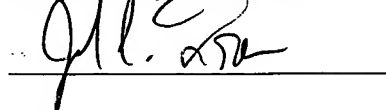
It is noted that the Office Action has asserted that Schneider et al.'s cable has a shield. This is not the case. While Schneider et al. does disclose a shield 114, that shield is for the sensor 102 and not the cable 20. Indeed, it does not make any sense to use a shield in Schneider et al.'s cable 20. Schneider et al.'s device is directed to measuring electromagnetic fields of cable 20. Since shielding the cable 20 would prevent Schneider et al.'s device from working for its intended purpose, there is no suggestion in Schneider et al. to use a shielded cable.

CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 1-11 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes

that an interview would be helpful to resolve any remaining issues, she is respectfully requested to contact the undersigned attorney at (312) 321-4200.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "J.C. Freeman", is written over a horizontal line.

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